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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,711	11/14/2003	Robert P. Badrak	WEAT/0127.C1	2073

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EXAMINER

THOMPSON, KENNETH L

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,711

Applicant(s)

BADRAK ET AL.

Examiner

Kenn Thompson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>29Dec, 14Nov 03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 28-32 and 39 are objected to because of the following informalities:

Claim 28 cannot depend from itself. For the sake of expediting the examination process the Examiner will treat claim 28 as to depend from claim 27.

Claims 29-32 depend from claim 28 and are likewise objected to.

The recitation "comprising" in claim 39, line 4 should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Baugh et al., U.S. 6,446,724.

Regarding claim 21, Baugh et al. discloses in figures 1-30 an apparatus for use in a wellbore. Baugh et al. discloses a tubular (10) having a preformed bypass (20,34) at an upper end thereof for circulating a fluid. Baugh et al. discloses a gripping surface (42) disposed on an outside surface of the upper end of the tubular, the gripping surface disposed circumferentially adjacent the preformed bypass.

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As to claim 22, Baugh et al. discloses a sealing band (26) disposed around the outside surface of the upper end.

As to claim 23, Baugh et al. discloses the gripping surface comprises teeth (70).

As to claim 24, Baugh et al. discloses the gripping surface comprises grit (col. 5, lines 48-51; cement is considered to be "grit").

As to claim 25, Baugh et al. discloses the gripping surface comprises a slip (col. 1, lines 14-17).

As to claim 26, Baugh et al. discloses the upper end (18) is tapered .

Regarding claim 27, Baugh et al. discloses an apparatus for use in a wellbore. Baugh et al. discloses a tubular (10) having a preformed bypass (34) for circulating a fluid; and a tool (82) having at least one radially extendable member (64).

As to claim 28, Baugh et al. discloses the at least one radially extendable member (64) of the tool (82) is disposed adjacent the preformed bypass (76).

As to claim 29, Baugh et al. discloses the tool is fluid pressure actuated by pressurized fluid delivered in a tubular string (col. 2, lines 13-18).

As to claim 30, Baugh et al. discloses a shearable connection (90) between the tubular (92) and the tool (94; 92 becomes deformed by forces tending to produce a shearing strain).

As to claim 31, Baugh et al. discloses an expander (16) capable of expanding a longitudinal section of the tubular.

As to claim 32, Baugh et al. discloses a gripping surface (70) disposed on an outside surface of the upper end of the tubular, the gripping surface disposed circumferentially adjacent the preformed bypass.

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Regarding claim 33, Baugh et al. discloses placing a tubular (10) in the wellbore, the tubular having a gripping surface (42) disposed on an outside surface of the tubular at a first location and a preformed bypass (34) for circulating a fluid disposed at a second location. Baugh et al. discloses expanding the tubular at the first location into substantial contact with an inner diameter of the wellbore (12), and circulating the fluid into the wellbore (col. 5, lines 27-40).

As to claim 34, Baugh et al. discloses expanding the entire circumference of at least a portion of the tubular (10) into substantial contact with the inner diameter of the wellbore (12; col. 5, lines 11-21).

As to claim 35, Baugh et al. discloses reforming the tubular (by complete circumferential expansion) and expanding the entire circumference of at least a portion of the tubular into substantial contact with the inner diameter of the wellbore (12; col. 5, lines 11-21).

As to claim 36, Baugh et al. discloses circulating the fluid into the wellbore comprises circulating cement into the wellbore through a run-in string and allowing returns to pass through the bypass (col. 2, line 65 – col. 3, line 3).

Regarding claim 37, Baugh et al. discloses placing a tubular (10) in the wellbore, the tubular having a preformed bypass (34) at an upper end thereof for circulating a fluid; expanding a portion of the tubular to selectively place portions (42) of the tubular circumferentially adjacent the preformed profile into frictional contact with a surrounding surface; and circulating the fluid into the wellbore.

As to claim 38, Baugh et al. discloses expanding the entire circumference of at least a portion of the tubular into substantial contact with the surrounding surface (col. 5, lines 11-21).

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As to claim 39, Baugh et al. discloses reforming the tubular (by complete circumferential expansion), and expanding the entire circumference of at least a portion of the tubular into substantial contact with the surrounding surface (col. 5, lines 11-21).

As to claim 40, Baugh et al. discloses circulating the fluid into the wellbore comprises circulating cement into the wellbore through a run-in string and allowing returns to pass through the bypass (col. 2, line 65 – col. 3, line 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 703 306-5760. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



29 April 2004